

JUN 07 2006

TRANSMITTAL OF APPEAL BRIEF (Small Entity)

Docket No.
BAF-15102/29

IN THE TRADEMARK OFFICE Application Of: Ferree

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
10/679,667	10/06/2003	A. Reimers	25006	3732	4076

Invention: MULTIAXIAL ARTIFICIAL DISC REPLACEMENTS

COMMISSIONER FOR PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

April 3, 2006

- Applicant claims small entity status. See 37 CFR 1.27

The fee for filing this Appeal Brief is: \$250.00

- A check in the amount of the fee is enclosed.
 The Director has already been authorized to charge fees in this application to a Deposit Account.
 The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 07-1180 . I have enclosed a duplicate copy of this sheet.
 Payment by credit card. Form PTO-2038 is attached.

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Signature

Dated: June 5, 2006

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on

June 5, 2006

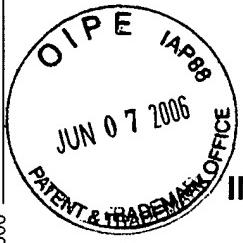
(Date)

Sheryl Hammer
Signature of Person Mailing Correspondence

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Typed or Printed Name of Person Mailing Correspondence

cc:



AF / DFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Ferree

Serial No.: 10/679,667

Group No.: 3732

Filed: Oct. 6, 2003

Examiner: A. Reimers

For: MULTIAXIAL ARTIFICIAL DISC REPLACEMENTS

APPELLANT'S BRIEF UNDER 37 CFR §1.192

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real party and interest in this case is Dr. Bret A. Ferree, Applicant and Appellant.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 15 claims. Claims 5-15 have been withdrawn from prosecution. Claims 1-15 are pending; however, claims 1-4 are rejected and under appeal. Claim 1 is the sole independent claim.

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**IV. Status of Amendments Filed Subsequent
Final Rejection**

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No after-final amendments have been filed.

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V. Summary of Claimed Subject Matter

Independent claim 1 is directed to a multiaxial artificial disc replacement (ADR), comprising a lower component (i.e., 104') adapted for fixation to an inferior vertebral body; an upper component (i.e., 104) adapted for fixation to a superior vertebral body; and an element (i.e., 102) that allows movement between the lower and upper components along only two separate, independent axes. (Specification, page 2, lines 10-23; Figures 4 and 10).

VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

- A. The rejection of claims 1-4 under 35 U.S.C. §112, first paragraph.
- B. The rejection of claims 1-4 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,401,269 to Buttner-Janz et al.

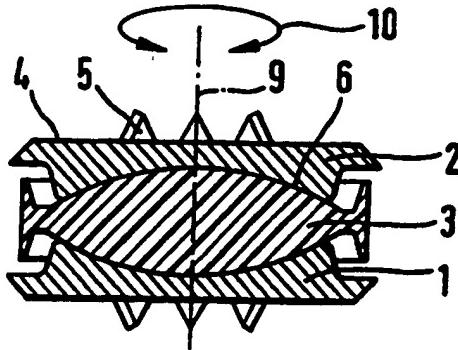
VII. Argument

A. The rejection of claims 1-4 under 35 U.S.C. §112, first paragraph.

Claim 1 includes the limitation of “an element that allows movement between the lower and upper components along only two separate, independent axes.” The Examiner argues that Appellant “only discloses a multiaxial ADR.” While Appellant does disclose “a multiaxial ADR,” Appellant discloses multiple embodiments. Indeed, “[i]n the preferred embodiment, a cruciate-shaped axle is provided to allow independent movement along orthogonal axes, much like a “universal joint.” Virtually every figure of the specification shows “an element that allows movement between the lower and upper components along only two separate, independent axes.” The rejection under 35 U.S.C. §112, first paragraph is without support and should be withdrawn.

B. The rejection of claims 1-3, wherein claims 2-3 stand/fall with claim 1

Claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,401,269 to Buttner-Janz et al. The Examiner argues that Buttner-Janz et al. disclose an element 3 “that is capable of allowing movement between the upper and lower components along only two separate, independent orthogonal axes.” Figure 1 of the ‘269 patent is reproduced below:



As is evident from this figure, element 3 *allows for rotation*. If the device allows for rotation, how can it be capable of allowing movement between the upper and lower components along only two separate, independent orthogonal axes? The answer is it can't.

Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). At the very least, the Examiner should articulate where, in the prior art, one would find the suggestion or motivation in support of the conclusion that the reference is "capable of" a particular function of interest.

That a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). In this case, the Examiner does not provide an

objective evidence or cogent technical reasoning in support of the conclusion of inherency. Accordingly, anticipation has not been established.

C. The rejection of claim 4.

Claim 4 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,401,269 to Buttner-Janz et al. The Examiner argues that Buttner-Janz et al. disclose an element 3 “with a cruciate-shaped axle.” “Cruciate-shaped” means “shaped like a cross.” Element 3 of Buttner-Janz et al. is depicted above. Appellant does not any “cruciate-shaped axle.” If the Examiner—or the Board—can identify such a feature, Appellant would appreciate the assistance.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board’s concurrence at this time.

Respectfully submitted,

By: _____

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Date: June 5, 2006

APPENDIX A

CLAIMS ON APPEAL

1. A multiaxial artificial disc replacement (ADR), comprising:
a lower component adapted for fixation to an inferior vertebral body;
an upper component adapted for fixation to a superior vertebral body; and
an element that allows movement between the lower and upper components along only two separate, independent axes.

2. The multiaxial ADR of claim 1, wherein the two axes are orthogonal to one another.

3. The multiaxial ADR of claim 1, wherein one of the axes is generally medial-lateral, and the other axis is generally anterior-posterior.

4. The multiaxial ADR of claim 1, wherein:
the element that allows movement between the lower and upper components is a cruciate-shaped axle; and
the axes are generally anterior-posterior and medial-lateral.

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APPENDIX B

EVIDENCE

None.

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APPENDIX C

RELATED PROCEEDINGS

None.